

REMARKS

In the Final Office Action¹, the Examiner took the following actions:

- i. rejected claims 9-16 under 35 U.S.C. § 101;
- ii. rejected claims 1-6 and 9-14 under 35 U.S.C. § 102(a) as being unpatentable over U.S. Patent No. 5,692,125 to Schloss et al. ("*Schloss*");
- iii. rejected claims 7 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Schloss* in view of "The Columbia Institute e-Campus School Policy Manual, November 2002" ("*Columbia*"); and
- iv. rejected claims 8 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Schloss* in view of U.S. Patent No. 6,099,320 to Papadopoulos ("*Papadopoulos*").

By this Amendment, Applicant proposes to amend claim 9 to more appropriately define the invention. Applicant also proposes to amend claims 6 and 14 to correct errors. Claims 1-16 are pending and under examination.

I. Rejection of Claims 9-16 under 35 U.S.C. § 101

Despite Applicant's amendments to claim 9 in an Amendment filed March 31, 2009, the Office Action continues to reject claims 9-16 under 35 U.S.C. § 101, based on

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

assertions identical to those presented in the non-final Office Action mailed January 28, 2009. Final Office Action, pp. 2-3.

Particularly, the Office Action alleges that "[t]he 'curriculum management system', as presented in claim 9, performs the insignificant extra-solution activity." Final Office Action, p. 2. However, Applicant respectfully notes that this recitation has already been deleted by the Amendment filed March 31, 2009. Furthermore, in that Amendment, Applicant has added "by a[/the] processor" in the claim elements. Applicant respectfully submits that these amendments have already established the statutory nature of the claim and thus overcome the rejection under 35 U.S.C. § 101 and are in full compliance with the Interim Guidelines issued August 2009 by the USPTO.

Nevertheless, by this Amendment, Applicant proposes to further amend claim 9 to even further establish the statutory nature of the claim.

In view of the above, Applicant respectfully submits that claim 9, as well as claims 10-16 dependent therefrom, is directed to statutory subject matter. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 9-16 under 35 U.S.C. § 101.

II. Rejection of Claims 1-6 and 9-14 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1-6 and 9-14 under 35 U.S.C. § 103(a) as unpatentable over *Schloss*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. ... [R]ejections on

obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1 calls for a combination including, for example, “determining whether the booking represents an individual booking or a curriculum booking” and “processing the modification to the booking based on at least whether the booking represents an individual booking or a curriculum booking” (emphases added). The

Office Action alleges that *Schloss* teaches these elements. Final Office Action, p. 4.

However, this is not correct.

Specifically, the Office Action cites column 11, lines 9-12 of *Schloss* for support of its allegation, asserting that *Schloss* teaches “check[ing] to see if there are any subsequent connected events and processes accordingly.” Final Office Action, p. 4. Even if *Schloss* could be reasonably argued to present this teaching, which Applicant does not concede, the “checking” steps of *Schloss* are not performed when modifying an event or events, rather, they are performed “at scheduling time to schedule an event group 260 or event 210.” *Schloss*, col. 10, ll. 63-65, see, also, col. 11, ll. 9-24. The portion of *Schloss* cited by the Office Action has nothing to do with a “modification” process.

In addition, when asserting that *Schloss* teaches “determining whether the booking represents an individual booking or a curriculum booking,” the Office Action also cites column 11, lines 9-12 of *Schloss* as support, alleging that *Schloss* teaches “check[ing] to see if the first event has any subsequent connected events: no would show an individual booking and yes would show a curriculum booking.” Final Office Action, p. 4. Even if this allegation were correct, which Applicant does not concede, *Schloss* does not use such a checking result to modify the event.

In fact, even if *Schloss* could be reasonably argued to teach modifying an event or events, which Applicant does not concede, *Schloss* specifies that whether to perform these modifications is based on whether one or more “dynamic conditions” are satisfied. *Schloss*, Abstract. Further, *Schloss* teaches that “dynamic conditions” are “data value

ranges” (*Schloss*, col. 2, l. 38), and particularly that “[d]ynamic conditions are conditions (and/or data) that can vary between the schedule time 251 and the performance time (256, 277). Typically, whether the dynamic condition is satisfied or not can not be determined until close to performance time” (*Schloss*, col. 4, ll. 61-65, emphases added). *Schloss* also presents some examples of dynamic conditions. See, e.g., *Schloss*, col. 10, ll. 37-43. Apparently, the checking results discussed in column 11, lines 9-12 of *Schloss* (and alleged by the Office Action as corresponding to the claimed “individual booking” and “curriculum booking”), which are obtained “at scheduling time to schedule an event group 260 or event 210” (*Schloss*, col. 10, ll. 63-65, emphasis added), are not dynamic conditions. Accordingly, even if *Schloss* taught “modifications,” which Applicant does not concede, none of these “modifications” is performed based on whether the event is “individual booking” or “curriculum booking.”

In view of the above, *Schloss* does not teach or suggest at least “processing the modification to the booking based on at least whether the booking represents an individual booking or a curriculum booking” as recited in claim 1 (emphases added).

Moreover, independent claim 1 also calls for a combination including, for example, “scheduling a booking of a course to be taken by a learner, wherein the scheduling comprises generating an attendance link that associates the learner with the course, the attendance link identifying whether the course is associated with a corresponding curriculum” and “determining whether the booking represents an individual booking or a curriculum booking based on the generated attendance link.” *Schloss* also fails to teach or suggest these elements.

The Office Action concedes that *Schloss* “does not explicitly disclose wherein a link is created to associate the user with the event and event information . . . [and] does not explicitly disclose using the link to determine whether the booking represents an individual booking or a curriculum booking.” Final Office Action, pp. 5-6. However, the Office Action then alleges that “it would have been obvious to one of ordinary skill in the art, at the time of the invention to have included” the above-noted features. See Final Office Action, pp. 5-6. As support for this allegation, the Office Action cites the *KSR* decision, quoting that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” Final Office Action, p. 5 and p. 6.

However, the proposition cited by the Office Action is not applicable because the Office Action has not demonstrated that the elements sought to be combined are “known.” Accordingly, Applicants note that MPEP § 2144.03 states, “If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” Applicants submit that the Office Action has made a generalized statement without any documentary evidence to support it. Applicant traverses the Examiner’s apparent taking of “Official Notice,” noting the impropriety of this action, as the Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.” See *id.* Should the Examiner maintain the rejection after considering the reasoning presented herein,

Applicant submits that the Examiner must provide "the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made," or else withdraw the rejection. See MPEP § 2144.03.

Therefore, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of independent claim 1. Moreover, there is no motivation for one of ordinary skill in the art to modify the teachings of the reference to achieve the claimed combinations. Thus, no reason has been clearly articulated as to why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1, and claim 1 is allowable over *Schloss*.

Independent claim 9, although different in scope from independent claim 1, recites similar elements and is therefore also allowable over *Schloss* for at least reasons similar to those set forth above for independent claim 1.

Claims 2-6 and 10-14 depend from independent claim 1 or 9. As such, *Schloss* also fails to render these claims obvious.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-6 and 9-14 under 35 U.S.C. § 103(a).

III. Rejection of Claims 7 and 15 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of dependent claims 7 and 15 under 35 U.S.C. § 103(a) as unpatentable over *Schloss* in view of *Columbia*. A *prima facie* case of obviousness has not been established.

Claim 7 and 15 depend from claim 1 or 9, and thus include all the elements thereof. As discussed above, *Schloss* fails to disclose or suggest at least “scheduling a booking of a course to be taken by a learner, wherein the scheduling comprises generating an attendance link that associates the learner with the course, the attendance link identifying whether the course is associated with a corresponding curriculum,” “determining whether the booking represents an individual booking or a curriculum booking based on the generated attendance link,” and “processing the modification to the booking based on at least whether the booking represents an individual booking or a curriculum booking,” as recited in claim 1 (with similar elements recited in claim 9) and included in claims 7 and 15.

The Office Action asserts that *Columbia* discloses the elements recited in claims 7 and 15. Final Office Action, pp. 8-9. Even if this assertion were correct, which Applicant does not concede, *Columbia* still fails to teach the above-noted elements and thus does not cure the deficiencies of *Schloss*.

Therefore, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claims 7 and 15. Moreover, there is no motivation for one of ordinary skill in the art to modify the teachings of the reference to achieve the claimed

combinations. Thus, no reason has been clearly articulated as to why claims 7 and 15 would have been obvious to one of ordinary skill in the art in view of the prior art.

Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 7 and 15, and these claims are thus allowable.

IV. Rejection of Claims 8 and 16 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of dependent claims 8 and 16 under 35 U.S.C. § 103(a) as unpatentable over *Schloss* in view of *Papadopoulos*. A *prima facie* case of obviousness has not been established.

Claim 8 and 16 depend from claim 1 or 9, and thus include all the elements thereof. As discussed above, *Schloss* fails to disclose or suggest at least “scheduling a booking of a course to be taken by a learner, wherein the scheduling comprises generating an attendance link that associates the learner with the course, the attendance link identifying whether the course is associated with a corresponding curriculum,” “determining whether the booking represents an individual booking or a curriculum booking based on the generated attendance link,” and “processing the modification to the booking based on at least whether the booking represents an individual booking or a curriculum booking,” as recited in claim 1 (with similar elements recited in claim 9) and included in claims 8 and 16.

The Office Action asserts that *Papadopoulos* discloses the elements recited in claims 8 and 16. Final Office Action, pp. 9-10. Even if this assertion were correct, which Applicant does not concede, *Papadopoulos* still fails to teach the above-noted elements and thus does not cure the deficiencies of *Schloss*.

Therefore, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claims 8 and 16. Moreover, there is no motivation for one of ordinary skill in the art to modify the teachings of the reference to achieve the claimed combinations. Thus, no reason has been clearly articulated as to why claims 8 and 16 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 8 and 16, and these claims are thus allowable.

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in condition for allowance. Applicant submits that the proposed amendments of claims 6, 9, and 14 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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